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09/864,084	05/22/2001	Phillip Andrew Seder	P0377	1802

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EXAMINER
LEMMA, SAMSON B

ART UNIT	PAPER NUMBER
2132	

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>11 March 2005</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4,8-17,19-29 and 31-38* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4,8-17,19-29 and 31-38* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some *   c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>03/11/2005</u>.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   This office action is in replay to an amendment filed on March 11, 2005. Claims

1,8,10,12-15,17,20, 22, 24, 31 and 38 have been amended and **claims 5-7,18 and 30** are

cancelled. **Claims 1-4,8-17,19-29 and 31-38** are pending.

2.   The Terminal disclaimer in response to the double patent rejection made by the

pervious office action has been received and is acknowledged to be placed of record in the file.

Response to Arguments

3.   Applicant's remark/arguments filed on March 11, 2005 have been fully considered but

they are not persuasive.

         Applicant first argued that the limitation in claim 10, "determining whether the

validation key has been previously received, and allowing access based on this determination"

is not addressed by the references on the record.

         Examiner disagrees with this argument.

Examiner would point out that Philyaw, the reference on record discloses and recites the

following. "In a typical contest, an important motive of the contest sponsor in conducting the

contest is to obtain information on the viewing or buying habits of the user. In such cases, the

supplemental validation data 2804 and/or the additional data 2806 in the RMP 2802 may

comprise user information retrieved from a user information database based on

correspondence with a user code 2606 in the UEMP 2602. Such user information may include

a telephone number for the user location, a post office address for the user location, an e-mail

address for the user location and/or demographic data regarding persons at the user location.

Preferably, such user information is collected prior to the contest, for example as part of a registration procedure, and stored in the user information database. This user information database may be a portion of the same database 2512 used by the reference computer 2510, or it may be a separate computer database operably linked to the reference computer." [Column 29, lines 19-47]. After retrieving the routing information 2704 from the computer database 2512, the reference computer creates a reply message packet ("RMP") for transmission back to the originating computer 2502.[column 28, lines 64-67]. Furthermore, Philyaw, discloses the following, "refereeing now to FIG. 30, there is illustrated an example of a VEMP employed in this embodiment. The VEMP 3002 includes user information 3004 for delivery to the target location 2516. The user information 3004 may be any information characterizing the user entering the contest, including the user code 2606, user information 2904 retrieved from the user information database, or user information retrieved from a cookie file 2544 on the user's computer. The user information 3004 is the minimum data which must be included for a VEMP 3002 to constitute an acceptable entry to the contest." [column 30, lines 34-44]. When the VEMP 3002 is received at the target address 2516, the user information 3004 and (if present) validation data 3006 and additional data 3008 are extracted by the target computer 2614. After receipt of the VEMP 3002 and extraction of the appropriate data, the contest computer 2514 then determines whether the VEMP 3002 constitutes an accepted entry.[Column 31, lines 2-5]. Therefore since the "VEMP 3002" contains the validation data, and the user data, and since these data are extracted and evaluated by the target computer the target computer will inherently determine whether or not the validation key has been previously received or not. Otherwise one user will provide the same validation key two or more times and have unfairly posses multiple chances instead of just single chance for winning the contest.

Applicant second argument is refereeing to claims 31 and 38.

Applicant argued that many of the features of the above claims were not discussed by the office action and gave an example that Philyaw is not understood to handle communicating to the user in different manners depending on whether the pointer falls within a predetermined class.

Examiner disagrees with this argument. Examiner will consider each limitations one by one.

Claim 31 and 38 recites similar claims with the following limitations.

A method of operating a computer server, [figure 25, ref. Num "2510" reference computer] **the computer server to communicate with at least one user terminal,**[figure 25, references "USER1-USER3" and the network "306"] said method comprising:

Receiving an identifier or document identifier form the user terminal, identifying a pointer associated with document/identifier. [figure 25, ref. Num "UEMP"; column 28, lines 11-22] (Once the selected article of commerce 2522 has been identified at the user location 2504, the desire to win the contest prize induces the user to find an article of commerce 2538 and enter the contest. As previously discussed, the user typically enters the contest by scanning the identifying indicia 2536 on the article 2538 with scanning device 2506. In response to the scanning, the software program 2508 on the user computer 2502 then automatically assembles a UEMP 2602 including an article code 2604, and also typically a user code 2606 and additional data 2608. Alternately, the UEMP 2602 can be assembled directly by the user. The UEMP 2602 is then routed across the network 306 to the reference computer 2510.)

Determining whether the pointer is a predetermined class, [column 29, lines Column 29, lines 19-column 30, line 6] (In particular Philyaw discloses after the document identifier identifying a pointer associated with document or "UEMP" is received at the reference computer/computer server shown on figure 25, ref. Num "2510", the reference computer extracts the user code 2606 from "UEMP" and access the user information database and retrieving the user information 2904 associated with the user code 2606 as explained on column 29, lines 54-63 and the determination is made whether or not the user is eligible to

participate in the contest, depending on whether or not the user code 2606 has been registered

for that predetermined class/identifying indicia shown on figure 25, ref. Num "2536") and **if**

not a predetermined class, communicating the pointer to the user terminal; [column 30,

lines 3-7] (If the pointer is not a predetermined class, it will have a validity status equals to No

indicating that the corresponding user is not eligible to participate in the contest and this will

be communicated to the user terminal with the RMP "2802" with the supplemental validity

status "No"]

      If the predetermined class, generating a validation key, and communicating the

pointer and validation key to the user terminal. [If the pointer is a predetermined class, it

will have a validity status equals to YES indicating that the corresponding user is eligible to

participate in the contest and this will be communicated to the user terminal with the

Validation Key, RMP "2802" with the supplemental validity status "YES"]. Therefore all the

limitations of claims 31 and 38 is explicitly or implicitly or inherently disclosed/taught by the

reference on the record.

      Applicant third argument is refereeing to claims 10, Applicant argued that even

though Philyaw may contemplate time stamps a determination is not based on whether a

time stamp includes a predetermined format.

      Examiner disagrees with this argument. Applicant admits that the validation key

comprises a time stamp but argued that the determination is based on whether the time stamp

comprises a predetermined format. The examiner point out that the time stamp which is

included in the validation key will inherently have its own format. As explained on column 31,

lines 12-15, Philyaw recites the following "then determining whether the VEMP 3002

constitutes an accepted entry will comprise evaluating the supplemental validation data 3006

for time stamp information relating to the time the UEMP was received at the reference

computer." Thus the time stamp will inherently contains its own format.

Applicant fifth argument is refereeing to claims 1, Applicant argued that claim recites the central server encodes the validation key through at least one of I) hashing ii) rotating and iii) converting the validation key to alpha-character and then adjusting the characters according to a code key, which is not taught or suggested by the reference on the record, "Philyaw"

Examiner disagrees with this argument. Examiner points out that Philyaw discloses the following, "In cases where the RMP 2802 includes sensitive information, or where the contest sponsors wish to reduce the possibility of cheating or fraud, at least a portion of the RMP 2802 may be encrypted using data encryption techniques known in the art and this meets all/some of the techniques of encoding that applicant recites as hashing, rotating or converting." [column 30, lines 10-14].

Applicant last argument is refereeing to claims 24, Applicant argued that claim recites a central server generates a validation key including at least one of a random and pseudo-random number, in combination with its other features. Philyaw is not understood to teach or suggest such a combination.

Examiner disagrees with this argument. Philyaw has disclosed the following , "As another example, if the contest rules require entries to be submitted within a certain period of time following identification of the selected article of commerce 2522, then the supplemental validation data 2804 in the RMP 2802 may comprise time-stamp information indicating the time at which the UEMP 2602 was received at the reference location 2510. As yet another example, if it is desired to "echo back" information received in the UEMP 2602 to the user, then the supplemental validation data 2804, and/or the additional data 2806 may include the article code 2604, **user code 2606**, which is unique and inherently assigned a random number so that two users can not have one and the same user code or additional data 2608 (such as the entire article identification code) which is also unique and is inherently assigned a random

number otherwise two different users will have one and the same article identification code,

were received in the UEMP 2602."[Column 29, lines 35-63]

Therefore validation key containing one of a random/pseudo random number is inherently

disclosed by Philyaw as discussed above.

Applicant's last argument is regarding the dependent claims.

Applicants argued that since the independent claims are patentable therefore all the claims

dependent thereon are also in condition for allowance for the same reasons argued for the

independent claims.

In response to the above argument by the applicant, the examiner replay discussed for the

independent claims above is also valid towards this argument.

Therefore every elements of the limitation of the claims including the newly added limitation to

some of the claims is explicitly or implicitly suggested and disclosed by the combinations of the

references on the record and the rejection remains valid.

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form

the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5.   **Claims 1-38** are rejected under 35 U.S.C. 102(e) as being anticipated by **Philyaw**

(hereinafter refereed to as **Philyaw**) (U.S. Patent No. 6,631,404).

6.   **As per claim 1 Philyaw** discloses a method for a method of regulating access to a

website by a user terminal via the internet, (Figure 16 and figure 25)

- The user terminal reading a document including an embedded digital

watermark, (column 27, lines 18-23) said method comprising the steps of:

- At the user terminal, extracting identifying data from the digital watermark,

(column 26, lines 58-column 27, line 2; column 27, lines 18-23) and

- Providing the identifying data to a central computer; (Column 28, lines 11-

23; figure 25, ref. Num "2510") (Central computer is met, reference computer "2510"

which is shown on figure 25, ref. Num "2510")

At the central computer:

- Identifying a pointer associated with the identifying data; (Column 28, lines

35-39; column 28, lines 39-63)

- Generating a validation key; and providing the pointer and the validation key

to the user terminal; (Column 28, lines 64-67; column 29, lines 1-18)

- Encoding the validation key through at least one of I) hashing ii) rotating and iii)

converting the validation key to alpha-character and then adjusting the characters

according to a code key; [column 30, lines 10-14].

At the user terminal,

- Communicating with the website via the pointer and providing the validation key to the website; (Column 30, lines 14-30; figure 25, ref. Num "2516") (website is met, target location "2516") and

At the website,

- Regulating access to the website by the user terminal based at least in part on the validation key.(Column 30, lines 66- column 31, line 5)

7.   **As per claim 10 and 20 Philyaw** discloses a method of authenticating permission to access a system comprising the step of:

- Receiving a request to enter the system, the request including at least a validation key; (Column 30, lines 66-column 31, lines 5; Column 31, lines 5-39)

- **Determining whether the validation key is valid**; [column 30, 66-column 31, line 5; column 31, lines 5-39) **wherein the validation key comprises a time stamp** and said determining determines whether the time stamp comprises a predetermined format; [column 31, lines 12-15] (As explained on column 31, lines 12-15, Philyaw recites the following "then determining whether the VEMP 3002 constitutes an accepted entry will comprise evaluating the supplemental validation data 3006 for time stamp information relating to the time the UEMP was received at the reference computer." Thus the time stamp will inherently contains its own format.) and

- **Allowing access to the system based on a determination of said determining step.** (Column 30, lines 66-column 31, lines 5; Column 31, lines 5-39)

8. **As per claim 24, 31 and 38 Philyaw** discloses a system for exchanging data comprising:

- A central server comprising at least one database including pointer information, (Figure 25, ref. Num "2510"; figure 25, ref. Num "2512";) (Central computer or central server is met the "reference computer" shown on figure 25, ref. Num "2510" and the database is met the database or "DB" shown on figure 25, ref. Num "2512") wherein

- When a user terminal communicates an extracted watermark identifier to said central server, said central server identifies a corresponding pointer associated with the extracted watermark identifier, (Column 28, lines 35-39; column 28, lines 39-63; column 27, lines 18-23; column 28, lines 11-23; figure 25, ref. Num "2510") and wherein

- Said central server generates a validation key including at least one of a random and pseudo-random number, and encodes the validation key, and wherein said central server appends the validation key to the corresponding pointer, and communicates the pointer and validation key to the user terminal.(Column 30, lines 8-19; column 32, lines 66-column 33, line 5)

9. **As per claim 2 and 16 Philyaw** discloses the method as applied to claims 1 and 10 above. Furthermore **Philyaw** discloses the method wherein the identifying data comprises a document identifier. (column 27, lines 18-23; column 25, lines 19-29)

10. **As per claims 3, 25 and 32-33, Philyaw** discloses the method as applied to claims 2, 24 and claim 31 above. Furthermore **Philyaw** discloses the method wherein the pointer

comprises at least one of a URL, IP address and web address. (Column 28, lines 59-63; column 32, lines 65-67)

11.   **As per claims 4, 11 and 26**, Philyaw discloses the method as applied to claims 2, 10 and 25 above. Furthermore **Philyaw** discloses the method wherein the validation key comprises a date-time value. (Column 30, lines 55-61)

12.   **As per claims 8 and 27-29**, Philyaw discloses the method as applied to claims 1 and 24 above. Furthermore Philyaw discloses the method further comprising the step of encoding the validation key wherein the encoding comprises at least one of hashing, encrypting, and rotating. (Column 30, lines 10-14)

13.   **As per claims 9, 21 and 34**, Philyaw discloses the method as applied to claims 1, 20, 24 and 32 above. Furthermore **Philyaw** discloses the method wherein the validation key comprises at least one of a time stamp, a predetermined number, and a pseudo-random number.(Column 30, lines 55-61)

14.   **As per claim 12**, Philyaw discloses the method as applied to claim 10 above. Furthermore **Philyaw** discloses the method further comprising the step of decoding the validation key. (column 30, lines 17-19)

15.   **As per claims 13-15**, Philyaw discloses the method as applied to claim 10 above. Furthermore **Philyaw** discloses the method said determining further determines whether the timestamp is stale. (column 30, lines 55-61;column 33, lines 1-16)

16.   **As per claims 17**, Philyaw discloses the method as applied to claim 10 above. Furthermore **Philyaw** discloses the method further comprising determining whether the validation key comprises a valid value.(Column 33, lines 1-15)

17.   **As per claims 19 and 23**, **Philyaw** discloses the method as applied to claim 10 and

claim 21 above. Furthermore **Philyaw** discloses the method wherein the request includes a

URL and the validation key is appended to the URL. (Column 32, lines 66-column 33, line 5)

18.   **As per claim 22**, **Philyaw** discloses the method as applied to claim 21 above.

Furthermore **Philyaw** discloses the method wherein said determining comprises: querying a

database to determine if the validation key is stored therein.(column 29, line 58- column 30,

line 5)

19.   **As per claims 35 and 37**, **Philyaw** discloses the method as applied to claim 34 above.

Furthermore **Philyaw** discloses the method wherein said document identifier comprises

an identifier extracted from a digitally watermarked document. (column 27, lines 18-23;

column 25, lines 19-29)

20.   **As per claims 36**, **Philyaw** discloses the method as applied to claim 35 above.

Furthermore **Philyaw** discloses the method further comprising encoding the validation

key (Column 30, lines 10-14)

Conclusion

21.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy

as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Samson B Lemma whose telephone number is 571-272-

3806. The examiner can normally be reached on Monday-Friday (8:00 am---4: 30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, BARRON JR GILBERTO can be reached on 571-272-3799. The fax

phone number for the organization where this application or proceeding is assigned

is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published

applications may be obtained from either Private PAIR or Public PAIR. Status

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more information about the PAIR system, see http://pair-direct.uspto.gov. Should you

have questions on access to the Private PAIR system, contact the Electronic Business

Center (EBC) at 866-217-9197 (toll-free).

SAMSON LEMMA

S·L

May 23, 2005

JUSTIN T. DARROW
PRIMARY EXAMINER